



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,479	07/02/2001	Allan B. Lamkin	70681	8448

22242 7590 11/09/2005

FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

LAYE, JADE O

ART UNIT	PAPER NUMBER
----------	--------------

2617

DATE MAILED: 11/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,479

Applicant(s)

LAMKIN ET AL.

Examiner

Jade O. Laye

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 24-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☒ Claim(s) 2-9 and 11-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. All information disclosure statements (IDS) submitted by the Applicant are in compliance with the provisions of 37 CFR 1.97. Accordingly, each has been considered by the Examiner.

Claim Objections

2. Claims 2-9 and 11-16 are objected to because of the following informalities:
- a. In Claims 2-9, each preamble lacks antecedent basis. Specifically, Claim 2 refers to a “computer program,” which is not mentioned in Claim 1. Claims 3-9 refer to a “method,” which is not mentioned in Claim 2.
 - b. In Claims 11-16, the preamble should also include the phrase “for play across multiple play platforms” as recited in Claim 1.
 - c. Regarding Claim 2, the phrase “...the recording medium...” and “...the plurality of directories...” lacks antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2617

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-13, 15-21, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by *Getsin et al.* (US Pat. No. 6,529,949)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

At the outset, the Examiner would like to provide some clarification for the following discussion. As you will see, many of the following rejections incorporate details of the ITX specification discussed in Applicant’s present application. This is because all details of the ITX specification discussed in the present application are inherently disclosed in the *Getsin* reference. At Column 30, Lines 18-26, *Getsin* teaches the use of DVD-video, which utilizes ITX. But, Applicant appears to provide no discussion addressing the details of ITX. However, throughout the present application, the Specification discusses the details ITX. Thus, it is logical for the Examiner to infer that all details of the ITX Specification discussed in the present application were present at the time of the *Getsin* reference. Therefore, although not discussed in the *Getsin* reference, the Examiner considers all aspects of the ITX specification discussed in the present application to be inherently contained within the *Getsin* reference.

As to Claim 1, *Getsin et al* disclose a system capable of providing integrated multimedia and HTML content to a client device across multiple play platforms. (Abstract; Col. 4, Ln. 1-20; Col. 5, Ln. 38-52; Col. 10, Ln. 38-45; Col. 11, Ln. 63-Col. 12, Ln. 9 & Ln. 23-28; Col. 18, Ln. 27-53; Col. 27, Ln. 38-Col. 28, Ln. 32). Moreover, it is inherent the ITX enable multimedia and HTML content to be reliably played across multiple playback platforms. (Applicant's Spec. Par. [53 & 54]). Accordingly, *Getsin et al* anticipate each and every limitation of Claim 1.

As to Claim 2, it is inherent the ITX accesses recorded content by calling one of a plurality of directories suitable for the client device. (Appl. Spec. Par. [88-98]). Accordingly, *Getsin et al* anticipate each and every limitation of Claim 2.

As to Claim 3, it is inherent the ITX directories include HTML content. (Appl. Spec. Par. [82-87]). Accordingly, *Getsin et al* anticipate each and every limitation of Claim 3.

As to Claim 4, *Getsin* further discloses the use of JavaScript files. (Col. 6, Ln. 8-11; Col. 11, Ln. 15-61; Col. 15, Ln. 59-Col. 16, Ln. 38). Accordingly, *Getsin et al* anticipate each and every limitation of Claim 4.

As to Claim 5, it is inherent the ITX directories comply with ISO-9660 standards. (Appl. Spec. Par. [83]). Accordingly, *Getsin et al* anticipate each and every limitation of Claim 5.

As to Claim 6, it is inherent the ITX directory contains platform specific code segments. (Appl. Spec. Par. [88-98]). Accordingly, *Getsin et al* anticipate each and every limitation of Claim 6.

As to Claim 7, it is inherent the ITX directories support hybrid Windows/Macintosh discs, thereby preserving resource forks for Macintosh operating systems. (Appl. Spec. Par. [84-86]). Accordingly, *Getsin et al* anticipate each and every limitation of Claim 7.

As to Claim 8, *Getsin* further teaches the system unlocks website content (i.e., HTML content) via the use of a DVD disk. (Col. 27, Ln. 37-Col. 28, Ln. 17). Accordingly, *Getsin et al* anticipate each and every limitation of Claim 8.

As to Claims 9 and 10, *Getsin* further discloses that HTML content can be provided via the Internet. (Col. 27, Ln. 49-55). Accordingly, *Getsin et al* anticipate each and every limitation of Claims 9 and 10.

As to Claim 11, *Getsin* further teaches that HTML content can be overlaid onto the media content. (Col. 13, Ln. 1-52). Accordingly, *Getsin et al* anticipate each and every limitation of Claim 11.

As to Claim 12, *Getsin* further teaches the system transmits supplemental data (advertisements, websites/HTML data, etc.) at specified time periods during playback (i.e., supplemental data scrolls with playback video) and the system utilizes JavaScript to communicate with the client devices. (Abstract; Col. 15, Ln. 59-Col. 16, Ln. 39; Col. 27, Ln. 38-Col. 28, Ln. 32). Accordingly, *Getsin et al* anticipate each and every limitation of Claim 12.

As to Claim 13, it is inherent from the rejection of Claim 12, that said supplemental data be synchronized with the playback data in order for the system to accurately time when said supplemental data is to be displayed/retrieved during playback. Accordingly, *Getsin et al* anticipate each and every limitation of Claim 13.

As to Claim 15, *Getsin* further teaches the user is allowed to browse on-line pages (i.e., HTML page includes links to websites). (Col. 29, Ln. 27-37). Moreover, the system is also capable of supplying the user with Internet access. (Col. 27, Ln. 38-Col. 28, Ln. 32). Accordingly, *Getsin et al* anticipate each and every limitation of Claim 15.

The limitations of Claims 16 and 17 are encompassed within the limitations of Claim 1. Thus, each is analyzed and rejected as discussed therein.

As to Claims 18 and 19, it is inherent that a ITX DVD contain HTML data. (Appl. Spec. Par. [71-72]). Since said DVD is located locally on the client device, the limitation of Claim 19 is encompassed here as well. Accordingly, *Getsin et al* anticipate each and every limitation of Claims 18 and 19.

The limitations of Claim 20 are encompassed within the limitations of Claims 1 and 10. Thus, it is analyzed and rejected as discussed therein.

The limitations of Claim 21 are encompassed within the limitations of Claims 1, 12, and 13. Thus, it is analyzed and rejected as discussed therein.

As to Claim 22, *Getsin* further discloses the multimedia content can be DVD content and that said DVD content can be supplemented with various data such as HTML content received from a server. (cited portions contained within the rejection of Claims 1 and 12). Accordingly, *Getsin et al* anticipate each and every limitation of Claim 22.

As to Claim 23, *Getsin* further teaches the use of “events” which allow the HTML content to be synchronized. (Col. 4, LN. 13-20 & Fig. 2). Accordingly, *Getsin et al* anticipate each and every limitation of Claim 23.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2617

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Getsin et al* in view of *Tomita et al.* (US Pat. No. 6,230,324).

Claim 14 recites the method of Claim 1, wherein the HTML content is in the form of an HTML page that starts a movie and checks for related Internet sites. As discussed above, *Getsin et al* anticipate each and every limitation of Claim 1, and further teach the user is allowed to unlock (i.e., start) multimedia data via a web page. (Col. 29, Ln. 27-51). But, *Getsin et al* fail to disclose the remaining limitations of Claim 14. However, within the same field of endeavor,

Art Unit: 2617

Tomita et al disclose a similar system which utilizes keywords located within the program stream to retrieve related URLs. (Abstract; Col. 4, Ln. 6-12, 27-35, 50-Col. 5, Ln. 8; Col. 6, Ln. 8-17). Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant's invention to combine the systems of *Getsin* and *Tomita* in order to provide a system which allows a user to receive supplemental information related to specified programming.

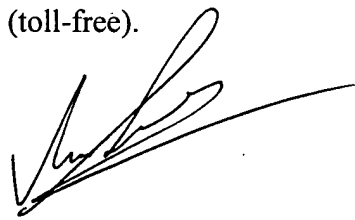
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Jade O. Laye
October 24, 2005.



VIVEK SRIVASTAVA
PRIMARY EXAMINER